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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/767,091

01/29/2004

Mridula Kini

J2066(C)

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7590

05/18/2006

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,091

Applicant(s)

KINI ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 6, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02-06-06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendment filed on February 6, 2006. Claims 1-15 are pending. Claim rejections made under 35 U.S.C. §§ 102(a) and 103(a) as indicated in the previous Office action dated November 18, 2006, are withdrawn in view of claim amendments made by applicants. Claim objection made in the same Office action was also withdrawn in view of the claim amendments. New rejections are made to address new claim limitations and new claims.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7, 9-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (WO 00/62740).

Claim 1 is directed to a composition comprising a) 0.05-10 % by weight of one or more of vitamin B3 compounds or derivatives thereof; b) 0.01-10 % by weight of allantoin; and c) a 19-99.9% by weight of stearic acid or 15-85 % by weight of a detergent active.

Robinson et al. disclose a method of making cosmetic compositions comprising vitamin B3 preferably in the amount of 2-5 % by weight. See p. 6. Example 6 teaches a skin cream composition comprising 3.5 % of niacinamide, 0.2 % of allantoin, and 2 % of titanium dioxide. See Example 6; instant claims 1, 2, 5-7, 11. See also Examples 7, 9-11. Examples 12 and 16 also meets the same claims as the formulations contain 2 % of niacinamide, 0.2% of allantoin, and 2 % of 4,4'-t-butylmethoxydibenzoylmethane.

Using The reference also discloses vitamin B3 compounds and their derivatives that are useful for the invention, which include nicotinic acid, nicotiny alcohol, esters of nicotinic acid esters, nicotiny amino acids, nicotiny alcohol esters of carboxylic acids, nicotinic acid N-oxide and niacinamide N-oxide. See p. 6, 2nd full par. – p. 8, 2nd par. See instant claim 3. Tocopherol nicotinate, a nicotinic acid ester, is one of the preferred compounds. For claim 9, the phrase “live-on” denotes the intended use of the composition, and no patentable weight is given.

The reference teaches varying the formulations into cleansers such as toilet bars, and also teaches using 1-90 % by weight of surfactants. See p. 27, 2nd full par. – 3rd par. See instant claims 1, 10 and 13.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to modify the teaching of Robins by adding the surfactants as taught, suggested, and motivated by the reference. The skilled artisan would have had a reasonable expectation of successfully producing a stable cleansing composition.

The reference also teaches on p. 46-47 that stearic acid is among the most preferred structuring agents for the composition. The reference teaches that structuring agent also emulsifies, stabilizes the composition, and assist in forming liquid crystal network, and are used in the amount of 0.1-20 % by weight. See p. 46.

It would have been obvious to the skilled artisan to modify the composition of Robin by adding stearic acid as taught, suggested, and motivated by the reference because the reference teaches that stearic acid is one of the most preferred structuring agent which emulsifies and stablizes the composition. The skilled artisan would have

had a reasonable expectation of successfully producing a stable composition comprising vitamin B3.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (WO 00/62740) as applied to claims 1-7, 9-13, and 15 as above, and further in view of Biedermann et al. (US 5833998).

Robinson et al. teach that the skin care composition is useful for regulating the condition of skin. See col. 3, line 66 – col. 4, line 65. While Robinson et al. teach further incorporating vitamins and cosmetic actives, the prior art differs from the present invention as it fails to specifically teach vitamin B₆ compound.

Biedermann et al. teach vitamin B complex topical composition for regulating the oily and/or shiny appearance of skin. The composition contains niacinamide or a mixture of niacinamide and a compound selected from pyridoxine (vitamin B₆), panthenol, and pantothenic acid. See col. 4, lines 22 – 36. The reference teaches that pyridoxine treats acne and skin inflammation and is used in antioxidant therapy. See col. 1, lines 66-col. 2, line 3. The reference teaches formulating the compositions in the form of lotions, creams and emulsions. See col. 4, lines 43 – 62.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Robinson et al. by incorporating pyridoxine (vitamin B₆) as motivated by Biedermann et al. because i) both prior arts are directed to topical compositions comprising vitamin B3 compounds that control skin conditions; and 2) Biedermann et al. teach combining niacinamide with pyridoxine to make a oil/shine control composition. The skilled artisan would have had

a reasonable expectation of successfully producing a stable cosmetic composition with the cosmetic benefits that are taught by the references since both references teach lotion and cream formulations.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (WO 00/62740) as applied to claims 1-7, 9-13, and 15 as above, and further in view of Poucher's Perfumes, Cosmetics and Soaps (2000) ("Poucher").

Robinson et al. fail to specifically teach using tallow fatty acid.

Poucher teaches that tallow fatty acid has been used to make soaps since "earliest days" and "continue to be the preferred principal raw material in Europe and most of America". See p. 455.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to modify the teaching of Robinson et al. by using tallow fatty acid to make a soap composition as motivated by Poucher because (i) Robinson et al. teach making soap comprising vitamin B3; and (ii) Poucher teaches that tallow fatty acid has been long known and used as the preferred soap base. The skilled artisan would have had a reasonable expectation of successfully producing a stable soap comprising vitamin B3.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Applicants' arguments regarding the anticipation rejection made in view of Robinson et al. are moot, as the rejection has been withdrawn in view of the claim amendment made by applicants.

With respect to the obviousness rejection made over Robinson et al. in view of Biedermann, applicants assert that the subject matter of these references are not within the technical field of the present invention. Specifically, applicants assert that Robinson is directed to regulating visible and tactile discontinuities associated with skin aging, while Biedermann is directed to compositions for regulating the oily and/or shiny appearance of skin. Examiner respectfully points out that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, examiner views that the references are in the field of applicants' endeavor, which is cosmetic composition art.

Furthermore, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, although the present invention is claimed to confer skin lightening property are asserting the present invention

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

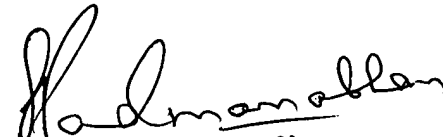
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER